

Q5

(h) precipitation; or
(i) controlling the evaporation of one or more of the components;
or a combination thereof.

Q6

52. (Amended) The method of claim 51, wherein the form of the compound-of-interest is a salt, hydrate, anhydrous, co-crystal, dehydrated hydrate, solvate, desolvated solvate, clathrate, or inclusion.

Q6

53. (Amended) The method of claim 39, wherein the array comprises two or more polymorphs of the compound-of-interest.

REMARKS

First, Applicants thank the Examiner for the informative telephone interview on May 31, 2002.

Claims 39, 43, 46, 49-50, and 52-53 have been amended to particularly point out and distinctly claim the invention. The specification has also been amended to correct the continuing-application information for the present application. No new matter has been added by way of these amendments to the specification or the claims. Support for the amendments to the claims can be found throughout the specification, in particular, at page 26, line 28 - page 27, line 14. Applicants respectfully request that the present amendments be entered and the present remarks be made of record in the file history of the present application.

Originally filed claims 1-169 were made subject to the ten-way restriction requirement and an election of species as set forth on pages 2-24 of the Office Action of March 27, 2002. The restriction requirement requires an election under 35 U.S.C. § 121 of one of ten inventions identified as corresponding to claims in groups I to X respectively, as set forth in the Office Action. Applicants respectfully traverse the restriction requirement since examination of claims 1-169 does not require separate or burdensome searches as alleged in the Office Action. Moreover, efficient examination of the application will be impeded by the ten-fold restriction requirement that multiplies the prosecution costs at least ten-fold while imposing significant administrative costs on the Applicants.

However, in the event the restriction is maintained, Applicants hereby provisionally elect, with traverse, Group III containing claims 39-59, with claims 39-42, 58 and 59 being generic to the group, drawn to a method for testing or optimizing one or more properties of a formulation.

In accordance with the aforementioned election of Group III, and in response to the Examiner's request for a species election, as set forth at paragraph 17, page 11 of the Office Action, Applicants elect, with traverse, the following species, and Applicants respectfully request modification of the elections of subgroups E and F. As the Examiner will see, no additional burden or difficulty in searching is imposed by the requested modification of subgroups E and F.

- Subgroup A: Type of difference (claim 43), Applicants elect species 3, identity of one or more components;
- Subgroup B: Analysis Method (claims 44-45), Applicants elect image analysis;
- Subgroup C: Further Analysis Method (claims 46-47)¹, Applicants elect Raman spectroscopy;
- Subgroup D: identity of compound-of-interest (claim 48 & 55-57), Applicants elect species 1, pharmaceuticals, particularly small molecules;²
- Subgroup E: identity of component (claim 49)³, Applicants elect solvent and salt forming component;

¹ Applicants respectfully point out that this analysis of claim 46 is not necessarily in addition to other analysis, but instead can be the only analysis. Indeed, the dependencies of claim 45 and 46 are distinct.

² Applicants respectfully traverse the Examiner's requirement that a specific compound be elected as unduly limiting and inappropriate given the claim language, focus of the method and disclosure of the application. Nevertheless, to be responsive, Applicants elect with traverse ritonavir.

³ Applicants respectfully point out that the recited election will actually aid in the search in view of the customary, but not required, practice of adjusting solvent and salt forming component simultaneously. In the event the Examiner does not agree to the modification, Applicants provisionally elect solvent with traverse. Applicants respectfully traverse the Examiner's requirement that a specific compound be elected as unduly limiting and inappropriate given the claim language, focus of the method and disclosure of the application. Nevertheless, to be responsive, Applicants elect with traverse ethanol.

- Subgroup F: type of processing parameter (claim 50), Applicants elect adjusting temperature and or the amount or concentration of the compound-of-interest or components⁴; and
- Subgroup G: type of Solid form (claims 51-54), Applicants elect crystalline. Applicants respectfully submit that all of the elected claims read on the elected species.

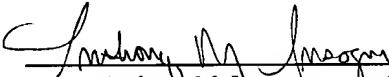
CONCLUSION

Applicants have traversed the restriction requirement and species elections and hereby request that either the restriction requirement and species election be withdrawn in view of the reasons recited herein or be made final. In the alternative, modification of the species election and acceptance of the provisional elections are respectfully requested. An early allowance of the application is earnestly requested. The Examiner is invited to contact the undersigned with any questions concerning the foregoing.

It is estimated that no fee in addition to that required for the extension of time is necessary for filing this response. In the event a fee is required, please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

Date July 26, 2002

 35,203
Anthony M. Insogna (Reg. No.)

PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090

⁴ Typically, but not as a requirement, both temperature and the amount or concentration of compound-of-interest or components are varied to effect crystallization. Thus, the election of all three is intended to assist the Examiner in the search in view of the discussion during the telephone conference. The election is consistent with the recitation of "combinations" in claim 50, but is made to avoid limiting the permissible scope of combinations. However, in the event the Examiner does not agree to the modification, then temperature may be used to direct an initial search followed by amount or concentration of compound-of-interest or components to further refine the search.